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| 10/603,504      | 06/24/2003  | Kazuo Takaragi       | 16869P-007410US     | 3227             |

20350 7590 09/23/2005

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

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| EXAMINER |
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PEIKARI, BEHZAD

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| ART UNIT | PAPER NUMBER |
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2189

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/603,504

Applicant(s)

TAKARAGI ET AL.

Examiner

B. James Peikari

Art Unit

2189

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/515,700.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/24/03 &amp; 4/8/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/515,700, filed on February 29, 2000. ***Information Disclosure Statement***
2. The information disclosure statement filed on June 24, 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, the relevance of Citation number AU has not been explained. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Oath/Declaration***

3. In the declaration filed on June 24, 2003, it appears that "the national or PCT international filing date of application" should be replaced with "the national or PCT international filing date of this application".

### ***Drawings***

4. The drawings are objected to because:

(a) The view numbers are not in accordance with 37 CFR 1.84(u)(1). For example, the two drawing figures associated with current FIG. 2 should be separately labeled "FIG. 2A" and "FIG. 2B".

(b) There is a smudge (possibly because of a scanning error) down the right hand side of each drawing figure, in most cases causing the lettering of the text in the drawings to be smudged. New copies of all drawings are required.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

5. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. For example, the specification is objected to because the title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Objections***

6. Claims 21-27 are objected to because of the following informalities: claims 21 and 23 consist of more than one sentence, note MPEP 608.01(m). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 21-24 and 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nishino et al., U.S. 5,857,024.

For purposes of this rejection, the claimed "authentication information" has been interpreted as a password, key or other authentication data and the claimed "accepted information" has been interpreted as payload data, operand data, user data or other

such data. In addition, the scope of the claimed "ID information" would include anything carried on a storage medium that would uniquely identify that particular storage medium, including ID data, unique manufacturing specifications, serial number, or even address data.

Nishino et al. is cited as just one example of systems that would teach the above claims as presently written, including:

A terminal coupled to a control apparatus having a database via a network (*note that one of the embodiments of the "information processing apparatus" comprising computer system 10, note column 4, lines 6-9, is a "terminal device connected to a network", note column 1, lines 17-19; note also that the claimed "database" may be taught by the plurality of registration data for different users stored on storage device 18, and a storage medium (IC card 30) having unique ID information (note the ID stored on ROM 38 of the IC card), the terminal comprising:*

*a unit that accepts input of information (note I/O device 24) to be stored in association with the ID information of the storage medium (note that the "accepted information" may be taught by the time data "t" that is encoded with the ID and password, note column 5, lines 47-58);*

*a unit that reads out the ID information from the storage medium (note I/O device 32);*

*a unit that transmits the accepted information and the ID information to the control apparatus via the network (note bus 26), to have the accepted information and the ID information related with each other and stored in the database (note that the time*

*data "t" is encoded with the ID, as well as a password and random cipher data, note column 5, lines 47-58, and the combination is "registered" into storage device 18 whenever the password is updated as in Figure 5);*

*a unit that receives a notice of the completion of the storing (this may be taught by the CPU 12, which in a computer system may keep track of what is being stored and what is being fetched) and a unit that indicates the completion of the storing in response to the receipt of the notice (i.e., to indicate to the user, e.g. via the display, that the updated password has been accepted; in addition, completion is indicated whenever the registered password is read out during a next access, note step 104);*

*wherein the storage medium further stores authentication information (note the storage of the password on RAM 40 of the IC card); the unit that reads out further reads out the authentication information from the storage medium (note that that I/O device 32 also reads out the password, as described above); and the unit that transmits further transmits the authentication information with the ID information (note that that I/O device 32 also reads out the password, in addition to the ID, stored time t and random cipher data are all encoded together and transmitted together, note column 5, lines 47-58), to have the validity of the ID information checked on the basis of the authentication information (note the password checking, column 6, lines 49-53); and*

*a unit that retrieves information which has been stored in the database and was retrieved based on the ID information (i.e., the unit that retrieves the password that relates to a particular ID to check for a match, note step 110).*

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 21-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,592,032. Although the conflicting claims are not identical, they are not patentably distinct from each other because each and all of the features of the present claims are in the claims of the patent.

### ***Allowable Subject Matter***

11. Claims 25 and 26 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims in one sentence.



***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Because of their particular relevance to the present claims, *applicant is strongly encouraged to consider each of these references* prior to formulating any response to this Office action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Peikari whose telephone number is (571) 272-4185. The examiner is generally available between 7:00 am and 7:30 pm, EST, Monday through Wednesday, and between 5:30 am and 4:00 pm on Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached at (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2189

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center at 866-217-9197 (toll-free).



B. James Peikari  
Primary Examiner  
Art Unit 2189  
9/20/05